

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board

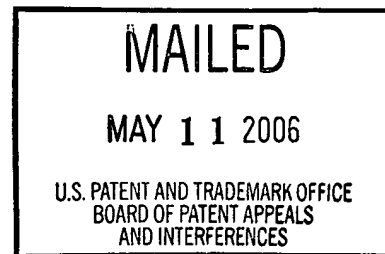
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPH SCHWEMLER,
THOMAS ELSNER, JURGEN HEUSER
and CHRISTIAN KORDS

Appeal No. 2006-1586
Application No. 09/933,360

ON BRIEF



Before KIMLIN, GARRIS, and FRANKLIN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 4 and 5. Claim 1 is illustrative:

1. A process for making a shaped product from thermoplastic polycarbonate comprising producing polycarbonate melt by a method selected from the group consisting of phase interface and melt transesterification and introducing the melt directly into a forming apparatus selected from the group consisting of an injection molding machine and an extruder, to form said shaped product, said process characterized in the absence therefrom of polycarbonate in granular form.

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The examiner relies upon the following references in the rejection of the appealed claims:

Woldenberg et al. (Woldenberg)	5,308,558	May 3, 1994
Regel et al. (Regel)	US 6,265,533 B1	Jul. 24, 2001

Appellants' claimed invention is directed to a process for making a molded product from thermoplastic polycarbonate. The method entails producing the polycarbonate melt by conventional phase interface or melt transesterification processes and introducing the melt into an injection molding apparatus or an extruder without first subjecting the polycarbonate to a granulation process. According to appellants, "[i]n the production plant [of conventional prior art processes], the resin is worked-up to reduce the contents of impurities and undesirable by-products and is shipped in vacuum tight containers to the molder in the form of pellets (granules)" (page 3 of brief, first paragraph). Appellants explain that the elimination of a melting step, which enables granulation, reduces the deteriorating aspect of thermal exposure on the polycarbonate.

Appealed claims 1, 4 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Woldenberg. Claim 2 stands rejected under 35 U.S.C. § 103(a) as being over Woldenberg in view of Regel.

Appellants do not present separate arguments for any particular claim on appeal. Accordingly, all the appealed claims stand or fall together with claim 1.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we find that the examiner's rejections are well-founded and in accordance with current patent jurisprudence. Accordingly, we will sustain the examiner's rejections.

There is no dispute that Woldenberg describes a process for making a shaped product from thermoplastic polycarbonate comprising the claimed steps of producing a polycarbonate melt by phase interface and introducing the melt produced into a forming apparatus, such as an injection molding machine and an extruder. Also, there is no dispute that Woldenberg fails to describe granulating solid polycarbonate and melting the granules before they are introduced into the extruder or injection molding machine. However, it is appellants' contention that since it is conventional in the art to employ a granulation step, and Woldenberg discloses that preliminary mixing of conventional additives may be carried out at room temperature, the Woldenberg disclosure must be read as including the conventional step of granulating.

We do not subscribe to appellants' position. Appellants have not established on the record that one of ordinary skill in the art would interpret Woldenberg as necessarily describing a granulation step that is not disclosed. Although it may be conventional in the art to granulate polycarbonate before it is shipped to a location for molding, such procedure is a commercial concern. In our view, one of ordinary skill in the art would reasonably find a description in Woldenberg of both commercial and non-commercial productions of molded polycarbonate, e.g., a pilot plant process or continuous process where the polycarbonate is both made and molded in the same plant. In such cases there would be no need to granulate the polycarbonate before it is molded. Consequently, we find that Woldenberg fairly describes, within the meaning of § 102, commercial and non-commercial processes that entail granulating and non-granulating, respectively, with the disclosure pertaining to mixing the conventional additives at room temperature being part of a commercial process that includes shipping of granules. While appellants want a granulating step to be read into the Woldenberg disclosure, appellants have not refuted the reasonable inference that Woldenberg's failure to

mention a granulating step is a teaching that one is not required. The limited scope of the Schnell article cited by appellants falls far short of such an interpretation.

We note that appellants do not set forth a separate substantive argument against the § 103 rejection of claim 2, but simply submit that Regel does not alleviate the asserted deficiency of Woldenberg.

One final point remains. In the event of further prosecution of the subject matter at bar, the examiner should consider a rejection under § 103 over the admitted prior art. Assuming, for the sake of argument, that all known processes for making molded polycarbonate include a granulation step, it is incumbent upon appellants to demonstrate that they have not eliminated a conventional step along with its attendant advantage. It is well settled that the omission of a feature disclosed by the prior art along with its disclosed advantage/function is a matter of obviousness for one of ordinary skill in the art. In re Thompson, 545 F.2d 1290, 1294, 192 USPQ 275, 277 (CCPA 1976); In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975); In re Marzocchi, 456 F.2d 790, 793, 173 USPQ 228, 229-30 (CCPA 1972); In re Larson, 340 F.2d 965, 969, 144 USPQ 347, 350 (CCPA 1965); In re Kegan, 331 F.2d 315,


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319, 141 USPQ 512, 515 (CCPA 1964); In re Porter, 68 F.2d 971,
973, 20 USPQ 291, 301 (CCPA 1934).

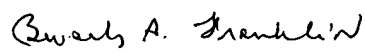
In conclusion, based on the foregoing, the examiner's
decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv) (effective Sept. 13, 2004).

AFFIRMED


Edward C. Kimlin)
Administrative Patent Judge)


Bradley R. Garriss)
Administrative Patent Judge)


Beverly A. Franklin)
Administrative Patent Judge)

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